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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,669	03/03/2004	Fumiko Shiraishi	Q80181	2713

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EXAMINER	
SHEEHAN, JOHN P	
ART UNIT	**PAPER NUMBER**
1742	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
31 DAYS	12/22/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/791,669	SHIRAISHI ET AL.	
	Examiner	Art Unit	
	John P. Sheehan	1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-28 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-28 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1, 2, 9, 12, 15, 18, 20, 21, 24 and 25, drawn to a method of making a magnetic particle comprising using a mixing and reaction device having a stirring vane rotating at a high speed in the interior of a mixer, a plurality of solutions are supplied to the interior of said mixer where the solutions are mixed and reacted with each other so that the peripheral speed in a leading end portion of said stirring vane is not less than 5m/second, classified in class 75, subclass 348.

II. Claims 3 to 5, 8, 10, 13, 16, 19, and 22, drawn to a method of making a magnetic particle comprising using a mixing and reaction device in which there is provided a reaction vessel which is filled with a bulk liquid and provided therein with a mixer which has a stirring vane rotating at a high speed and is provided with an opening through which said bulk liquid is circulated to and from the interior of said reaction vessel, a plurality of kinds of solutions for preparing said alloy particle are supplied to the interior of said mixer, where the plurality of kinds of solutions are mixed together and caused to react with each other by a liquid phase process, and at the same time the plurality of kinds of solutions are mixed together and caused to react with each other so that a mixed reaction solution is

discharged from said mixer to said reaction vessel by a circulating stream of said bulk liquid, classified in class 75, subclass 348.

III. Claims 6, 7, 11, 14, 17, 23 and 26, drawn to a method of making a magnetic particle comprising using a mixing and reaction device which is provided with a mixer in the interior of a reaction vessel and has a microgap formed between an inner wall of the mixer and a stirring member rotating at a high speed and in which in order to form this microgap, when the distance from the center of rotation of said stirring member to a leading end thereof is put as 1, the distance to said inner wall having the shortest distance from the center of rotation of said stirring member is set in the range of 1.001 to 1.200, a plurality of kinds of solutions for preparing said alloy particle are supplied to said microgap, where the plurality of kinds of solutions are mixed together and caused to react with each other by a liquid phase process, and at the same time the plurality of kinds of solutions are mixed together and caused to react with each other so that the mixed reaction solution is discharged from said microgap, classified in class 75, subclass 348.

IV. Claims 27 and 28, drawn to a magnetic powder manufactured by the Group I process and magnetic memory medium containing said powder, classified in class 428, subclass 800+.

The inventions are distinct, each from the other because of the following reasons:

2. The Group I, Group II and Group III inventions are distinct in that they are capable of separate manufacture, use, or sale as claimed and are patentable (novel and unobvious) over each other (though they may each be unpatentable because of the prior art), MPEP 802.01. Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

3. Inventions IV and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as chemical vapor deposition or by the processes of Groups II and III. While it is noted that claims 27 and 28 are product-by-process claims and incorporate the same process steps as described in the process of Group I, a product defined by the process by which it can be made is still a product claim (In re Bridgeford, 149 USPQ 55 (CCPA 1966)) and can be restricted from the process if the examiner can demonstrate that the product as claimed can be made by another materially different process such as the alternative process described above. See In re

Brown, 173 U.S.P.Q 685, and In re Fessmann, 180 U.S.P.Q. 324, for analysis of weight given to process step recitations in product claims also see MPEP 2113 and 806.05(f).

4. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02) and because the examination of all of the above delineated inventions in a single application would require additional analysis of the prior art, formulation of rejections, evaluation of applicants' arguments and consideration of different issues of patentability, restriction for examination purposes as indicated is proper.

5. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

6. The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

7. Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions

unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (571) 272-1249. The examiner can normally be reached on T-F (6:45-4:30) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John P. Sheehan
Primary Examiner
Art Unit 1742

JPS